REMARKS

Claims 1-33 remain pending in the present application. Applicants have amended Claims 1, 18, and 24 to more clearly define the present invention.

Claims Rejected under 35 U.S.C. § 103(a) Over Sobol and Hawes

Claims 1-6, 9-10, 16, 18, 21, 23, 24, 27, 29, 30, 32, and 33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sobol et al. (U.S. Patent No. 5,907,665, hereinafter Sobol) in view of Hawes (U.S. Patent No. 6,094,662 B1, hereinafter Hawes). Applicants respectfully disagree that the cited prior art renders any of the claims obvious. However, in the interest of reducing the complexity of the issues for the Examiner to consider in this response, the following discussion focuses on independent Claims 1, 18, and 24, and the patentability of every dependent claim is not necessarily separately addressed in this response. Applicants' decision not to discuss the differences between the cited art and each dependent claim in the present application should not be considered as an admission that applicants concur with the Examiner that the dependent claims are not patentable over the disclosure in the cited references. Instead, applicants believe that the dependent claims also patentably distinguish over the references cited. As will be clear from the following remarks, the independent claims in the present application recite an invention that is patentable. Because the dependent claims inherently include all of the elements of the independent claim from which they ultimately depend, all of the dependent claims are patentable for at least the same reasons as the independent claims.

As to independent Claim 1, the Examiner refers to the background section of Sobol when asserting that "Sobol discloses the acquisition, and insertion of a scanned image, with the aid of an active scanner, into a document(s)" (Office Action, page 2, section 4). Specifically, Sobol states that "While application programs exist that will allow user to import a binary image data file of scanned line art image into [ ] a document, the scanned image reproduced thereby is often of inferior quality" (Sobol, col. 2, lines 6-10). Sobol attempts to address the inferior quality of scanned grayscale image data, such as stair-step "jaggies," by changing light gray pixels to white pixels, changing dark gray pixels to black pixels, compressing the changed image data, and scaling or otherwise transforming the compressed image data for use in a document.

The Examiner admits that "Sobol fails to explicitly disclose: *inserting data representing said image . . . all without saving said data in other than a temporary buffer*" (italics in original, Office Action, page 2, section 4). Instead, the Examiner refers to a portion of Hawes as teaching the insertion of an image, and storage of the image in a cache or temporary buffer. The Examiner concludes that "It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Sobol and Hawes, because Hawes teaches above the efficient storage of images" (Office Action, page 3). Even if Hawes teaches an efficient

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method for storing images, Hawes does not disclose or suggest inserting image data without saving the data, as claimed by applicants. Hawes is directed to marking portions of a Web page as cacheable. Specifically, "The browser 180 separates the web page 212 into cacheable portions to be stored in the cache portion 184 of the memory 172 and non-cacheable portions to be stored in other, non-cache, portions of the memory 172" (Hawes, col. 4, lines 50-53). Hawes explains that "in the general case, the non-HTML portions, such as GIFs, or bitmaps or other image portions are stored as cacheable information" (Hawes, col. 5, lines 9-11). Thus, images are cacheable information of a Web page, and the images are stored in the cache portion of memory. The benefit of Hawes is that "the page can be reloaded without transferring large graphics images if those graphics images have not changed from the graphics images stored in the browser's cache" (Hawes, col. 2, lines 61-64). However, Hawes states that "In the browser of this invention, the **hard disk** is used to cache the information available on the Web" (emphasis added, Hawes, col. 4, lines 10-11).

Moreover, Hawes disclosure and teachings are not related to inserting image data into a document containing text created with an application program on the same computer that is in communication with the image source device, as clarified in the amended claims. Hawes is directed to updating the display of Web pages that are downloaded from a remote server and rendered by a browser on the user's client computer. Hawes correctly specifies that "A browser is a computer program which enables a user to look at information on other computers and retrieve information from other computers in an environment that allows for cross-platform communications" (Hawes, col. 1, lines 58-62). Hawes does not disclose or suggest creating a Web page document with an application program on the user's client computer. Hawes also does not disclose or suggest that an image is obtained from an active image source device in communication with the user's client computer. Conversely, Sobol does not disclose or suggest Web pages, a browser, or any other aspect of Hawes that would motivate one of ordinary skill in the art to select and combine Sobol and Hawes.

The Examiner indicates that one of ordinary skill in the art would be motivated to combine Hawes with Sobol, because the Examiner believes that Hawes teaches efficient storage of images. However, Hawes does not disclose or suggest any storage efficiency that is of any use to Sobol. Sobol requires storage efficiency only in the form of data compression whereby image data are "compressed by a conventional data compression technique, such as run-length encoding" (Sobol, col. 4, lines 64-65). Sobol explains that "The method [ ] minimizes the amount of memory required to store the image data by compressing the image data before performing any image transformation processes (e.g., scaling and/or rotation)" (Sobol, col. 5, lines 6-9). However, Hawes discloses a technique for reducing the time required to transmit data from a remote device, not by reducing the

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data size, but by eliminating the need to retransmit from the remote device, data that have not changed. Eliminating some retransmission of data does not compress the image data for more efficient transformation processes. Thus, one of ordinary skill in the art would not be motivated to select and combine Sobol and Hawes. Accordingly, the rejection under 35 U.S.C. § 103(a) of independent Claim 1 as amended should be withdrawn.

As to independent Claim 18, the Examiner appears to have misunderstood the claim language. The claim language is amended to clarify its meaning. The Examiner indicates that "Sobol fails to explicitly disclose: ***insertion*** *scheme for selecting a plurality of the stored multiple images for insertion into the document*" (italics in original, emphasis added, Office Action, page 4). The Examiner apparently refers to step (a) of Claim 18. However, step (a) recites an image source device user interface that provides a "selection" scheme, not an insertion scheme. Correspondingly, step (b) provides for enabling a user to select a plurality of images. Nevertheless, the Examiner misinterpreted step (a), and referred to the background section of Hawes as teaching "the selection and insertion of images into a web page" (Office Action, page 4). The cited background refers to generating a Web page with an editing language, such as hypertext markup language (HTML). Specifically, Hawes indicates that "HTML allows for the embedding of images, sounds, video streams, form fields and simple text formatting into a page" (Hawes, col. 1, lines 43-44). While an HTML editor will allow a user to embed such items into a page, Hawes does not disclose or suggest that an HTML editor comprises an image source device user interface running on a computer in communication with an image source device that stores image source data comprising multiple images, as the amended claim language now recites. Further, Hawes does not disclose or suggest that a browser enables an image source device user interface for ***selecting*** a plurality of the stored multiple images. The browser does NOT enable the user to select the images that will be ***inserted*** into the received Web page. Thus, Hawes does not provide the claim element that the Examiner admits is missing from Sobol. Accordingly, the rejection under 35 U.S.C. § 103(a) of independent Claim 18 as amended should be withdrawn.

With regard to independent Claim 24, the Examiner indicates that the claim is directed towards a system for implementing the steps found in Claim 1, and therefore rejects the claim on the same grounds as Claim 1. Applicants have amended Claim 24 in a manner corresponding to the amendment to Claim 1. In light of the amendments and remarks set forth above with regard to Claim 1, the rejection under 35 U.S.C. § 103(a) of independent Claim 24 as amended should be withdrawn.

Also, a dependent claim inherently includes all elements of the independent claim from which the dependent claim depends (MPEP § 608.01(n)). Thus, a dependent claim is patentable for at least the same reasons as its base independent claim. Therefore, the rejection of dependent

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Claims 2-17, 19-23, and 25-33 should be withdrawn for the reasons noted above, in regard to independent Claims 1, 18, and 24, as amended. Moreover, in regard to Claims 3 and 6, the Examiner provides no indication that Sobol or Hawes discloses or suggests the additional elements of these two claims. Instead, the Examiner arbitrarily rejects these claims on the basis that they are directed towards a method for implementing the steps found in a previous claim. Because the Examiner has not provided any well reasoned justification for rejecting these claims, their rejection should be withdrawn.

Claims Rejected under 35 U.S.C. § 103(a) Over Sobol, Hawes, and Photoshop

Dependent Claims 7, 8, 19, 22, 25, and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sobol in view of Hawes, and further in view of "Mastering Photoshop 5 for the Web" (1998, pp. 1-10, hereinafter "Photoshop"). Applicants respectfully disagree that one of ordinary skill in the art would be motivated to consider the teaching of the Photoshop reference for any combination with Sobol. Sobol is directed to "the transformation of **grayscale** image data" (emphasis added, Sobol, col. 1, lines 6-7) in the form of line art drawings (See Sobol, col. 1, line 62 through col. 2, line 6). There is no reason to enable Sobol to perform any image enhancement, because Sobol specifically changes the grayscale image data to discrete black and white image data. Specifically, Sobol first reduces "the number of gray image pixels by 'punching to black' gray image pixels having intensity values less than a black punch value and by 'punching to white' gray image pixels having intensity values greater than a white punch value" (Sobol, col. 3, lines 21-26). Sobol explicitly states that "The grayscale image data produced by [a] high resolution re-scan are not changed or manipulated by the scanning utility 22, but fed directly to the image handler 18" (Sobol, col. 7, lines 51-54). The image handler performs the "punching" so that "all pixels having intensity values less than the black punch value 44 are assigned the intensity value corresponding to black (i.e., 0), whereas all pixels having intensity values greater than the white punch value 46 are assigned the intensity value corresponding to white (i.e., 255)" (Sobol, col. 7, line 65 through col. 8, line 3). If enhancements, such as contrast, brightness, or color level, were allowed, Sobol would not produce the proper "punched" image. Thus, Sobol teaches away from any combination with Photoshop that enables altering or enhancing an image. Accordingly, the rejection under 35 U.S.C. § 103(a) of dependent Claims 7, 8, 22, and 31 should be withdrawn. The rejection of Claim 11 over Sobol, Hawes, Photoshop, and further in view of "Troubleshooting and Configuring the Windows NT/95 Registry," Clayton Johnson (1997, pp. 1-2, hereinafter "Troubleshooting") should be withdrawn for the reasons above that one of ordinary skill would not be motivated to select and combine Photoshop with Sobol.

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The rejection of dependent Claims 19, 25, and other dependent claims not specifically addressed should be withdrawn for the reasons stated above regarding the patentability of the independent claims from which the dependent claims ultimately depend.

Claims Rejected under 35 U.S.C. § 103(a) Over Sobol, Hawes, and ADF

Dependent Claims 12, 13, 15, and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sobol in view of Hawes, and further in view of "IBM ADF Color Scanner User's Guide" (7/1997, pp. 14-22 and figs. 1-16, hereinafter "ADF"). Applicants respectfully disagree that the cited references teach or suggest all of the claim elements. The Examiner refers to a portion of the ADF reference that introduces a user interface function for enabling a user to define or change one of four predefined actions that can be performed by the color scanner. For each of the four actions, ADF explains how a user should complete a number of parameter fields for an input dialog box to create or change one of the predefined actions. For example, ADF explains that one of the steps necessary to define a copy action is to "Go to the Settings list box and select a copy type" (ADF, page 15). As another example, under the description for defining the Scan and Save action, ADF requires the user to "Verify or change the scan mode, brightness, contrast, resolution, disposition, and document type information on the SCAN & SAVE screen" (ADF, page 19). Because the user must select image capture parameters in this cited prior art, ADF does not disclose or suggest the element of Claim 12, recited as "determining whether the image source device that is active is able to perform an automatic image scan, wherein the automatic image scan comprises the steps of comprises the steps of capturing an image of a graphic source with said image source device and inserting the data representing the image into the document, **all without requiring a user to select image capture parameters**." (Emphasis added.) Accordingly, the rejection under 35 U.S.C. § 103(a) of dependent Claim 12 should be withdrawn. Because Claims 13, 15, and 17 depend from Claim 12, the rejection of Claims 13, 15, and 17 should be withdrawn for at least the same reasons as Claim 12. Also, as discussed above, the rejection of other dependent claims not specifically addressed should be withdrawn for the reasons above regarding the independent claims from which the dependent claims depend.

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In view of the preceding amendments and remarks, it will be apparent that all claims in this case currently define a novel and non-obvious invention, and that the application is in condition for allowance and should be passed to issue without further delay. Should any further questions remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

Respectfully submitted,

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RMA/TRM:

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Director of Patents and Trademarks, Arlington, VA 22202, on October 7, 2002.

Date: October 7, 2002

Kathy L Pavia

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MARKED-UP VERSION OF THE AMENDMENTS

Amendment to the Specification

In the Specification:

Please amend the specification as follows:

On Page 4, the paragraph beginning at line 6 should be amended as shown below.

According to [a second] another aspect of the invention, the method allows the user to select the image acquisition device through a dialog that contains a drop-down menu control populated with a list of one or more image acquisition devices available to the user, thereby bypassing TWAIN's select source dialog, which is normally required when using TWAIN for acquiring images. The dialog also enables the user to select a predetermined resolution level, corresponding to whether the document is to be primarily viewed in printed form or as an online document (e.g., as a web page).

Amendment to the Claims

In the Claims:

Please amend Claims 1, 18, and 24 as follows:

1. (Amended) A method for inserting an image into a document, [having a text content produced by an application program, the application program executing on a computer in communication with at least one image source device, the method] comprising the steps of:

(a) making an image source device active, wherein the image source device is in communication with a computer executing an application program used to create a text content of said document;

(b) acquiring an image using the image source device that is active; and

(c) inserting data representing said image into said document so that the image appears in the document and comprises a portion of the document, all without saving said data in other than a temporary buffer.

18. (Amended) A method for inserting a plurality of images into a document, [having a text content that is produced with an application program, the application program running on a computer in communication with an image source device that stores image source data comprising multiple images, the method] comprising the steps of:

(a) enabling an image source device user interface [that] with an application program used to create a text content of the document and running on a computer in communication with an image source device that stores image source data comprising multiple images, wherein the image source device user interface provides a selection scheme for selecting a plurality of the stored multiple images for insertion into the document;

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(b) enabling a user to select a plurality of images to be inserted into the document;

(c) transferring data representing the selected images from the image source device to the computer;

(d) converting said data representing the selected image into a compressed format; and

(e) inserting said compressed format image data into the document so that the document includes the plurality of images.

24. (Amended) A system for inserting an image into a document, [produced by an application program, the system] comprising:

(a) a computer having a memory and a processor, the memory storing machine instructions that are executable on the processor;

(b) an application program comprising machine instructions that are stored in the computer memory, said application program having been used to create the document;

(c) an image acquisition device connected in communication with the computer and providing image data representing an image;

(d) a source driver module comprising computer-executable instructions stored in the memory and in communication with the image acquisition device so as to control acquisition of an image from the image acquisition device;

(e) a source manager module comprising computer-executable instructions stored in the memory and in communication with the source driver module, the source manager module providing commands to the source driver module to acquire an image from the image acquisition device; and

(f) an interface module comprising computer-executable instructions stored in the memory and in communication with the source manager module and the application program, the interface module providing commands to the source manager to acquire an image from the image acquisition device, the data representing the image being inserted into the [application program] document.

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